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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,424	01/16/2004	Hironao Minato	2038-224A	5649
7590	01/25/2006			EXAMINER
LOWE HAUPTMAN GILMAN & BERNER, LLP			REICHLE, KARIN M	
Suite 300			ART UNIT	PAPER NUMBER
1700 Diagonal Road				
Alexandria, VA 22314			3761	

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/758,424	MINATO, HIRONAO	
	Examiner Karin M. Reichle	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 16 January 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 8-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 8-16 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 16 January 2004 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. 09/259,687.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/16/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## DETAILED ACTION

### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

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The cross reference to the parent application filed 1-16-04 in the transmittal papers could not be entered because such was not compliant with 37 CFR 1.121 effective 7-30-03, e.g. not in a separate section subtitled amendments to the specification. The next response, if any, should

resubmit such reference in compliance with 37 CFR 1.121 if Applicant desires to continue the priority claim to the parent application.

*Specification*

*Drawings*

2. The drawings are objected to because the arrow Y in Figure 4 should go in the opposite direction (It is noted that contrary to Applicant's remarks in the preliminary amendment of 1-16-04 no replacement sheet of drawings or annotated sheet were attached). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Description***

3. The disclosure is objected to because of the following informalities: the Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims are not commensurate, see MPEP 608.01(d).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. Claims 11-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 8, 11 and 14, and thus claims 9-10, 12-13 and 15-16, now require a holding force of the adhesive layers against the outer surface of the diaper being sufficient to hold the diaper in a rolled state after use. Contrary to Applicant's remarks in the preliminary amendment of 1-16-04, the original specification at page 8, lines 4-6 does not provide support for this additional limitation because such does not set forth that the adhesive force of the fasteners is that of the adhesive layers and that such force is utilized against the outer surface to hold the diaper in the rolled up state. If Applicant maintains such claim language, the specific portion of the specification relied upon for claim language which is commensurate in scope therewith should be set forth. Claim 9 now requires the inner surface of the backsheet which surface was defined in claim 8 as solely defining the release portions and which sheet was defined in claim 8 as being made of a plastic sheet as being surface treated to facilitate peeling of the adhesive

layers therefrom. It is noted that paragraph 21 does not specify any details of the claimed surface treatment, i.e. does not teach a release zone defined solely by the inner surface of a backsheet made of a plastic sheet which inner surface is also surface treated, i.e. treatment can't form inner surface. Furthermore, the portion of the specification relied upon by Applicant to support such claim, again page 8, line 4-6 of the original specification, does not even describe surface treatment. Again, if Applicant maintains such claim language, the specific portion of the specification relied upon for claim language which is commensurate in scope therewith should be set forth. Claims 10, 13, and 16 now require the holding forces of the adhesive layers and the loop member not being higher than those of the hook and loop members to prevent the presence of the adhesive layers from obstructing smooth peeling of the hook and loop members. While paragraph 19 of the substitute specification discusses smooth peeling it does not discuss the holding forces as claimed. Furthermore, the portion of the specification relied upon by Applicant to support such claims, again page 8, line 4-6 of the original specification, does not even describe such relative holding forces. Again, if Applicant maintains such claim language, the specific portion of the specification relied upon for claim language which is commensurate in scope therewith should be set forth.

#### *Claim Language Interpretation*

5. The claim language discussed in the preceding paragraph will be treated on the merits, see 2163.06, I. Claims 9, 12 and 15 recite the inner surface of the backsheet or the loop member being surface treated to facilitate peeling of the adhesive layers therefrom, i.e. these claims are product by process claims, see MPEP 2113, i.e. “[E]ven though product-by-process claims are

limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” Therefore these claims are interpreted to require an end product in which the inner surface of the backsheet or the loop member includes the capability, property or function of facilitating peeling of the adhesive layers therefrom.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lingertat et al '025 in view of Battrell '276 and Hartmann DE '981.

With regard to claim 11, the Lingertat et al device at Figures 5-6, col. 1, line 63-col. 2, line 8, col. 2, lines 60 et seq., col. 3, lines 57-65, col. 4, lines 4-60 teaches all the claimed structure except for 1) “hook” and “loop” members and the adhesive coated on the “hook” members and 2) a holding force of the adhesive against the outer surface of the diaper being sufficient to hold it in a rolled state. The topsheet is 12, the backsheet is a portion of 16, the core is 14, the release zones are 16, 28b and 34a, the extensions are 16 adjacent 28a, adhesive is 28a, the plastic sheet is 34a. It should be noted that the expanded adhesive areas of the Lingertat ears

or flaps 16a, compare Figures 5 and 1, are considered the pair of extensions because the claim does not require the extensions be separate or discrete pieces of material, i.e. could be integral and monolithically formed with the extended portions of the backsheet, i.e. each extension is in the form of a tape integrally and monolithically fixed to the outer surface of the backsheet and side edges. It is further noted that the claim does not require the release zones to be defined only by the inner surface of the backsheet, i.e. Lingertat's backsheet inner surface is treated by the adhesive and release sheet 43a to facilitate the peeling of the adhesive layers therefrom. It is further noted the back sheet is claimed as including a plastic sheet having an exposed surface defining the inner surface. With regard to 1) as set forth in the cited portions of Lingertat, it is desired to use pressure sensitive adhesive areas to secure the diaper in place. Battrell at the abstract, Figures 1-6, col. 1, line 20- col. 2, line 66, col. 4, lines 43-48, e.g. can be hook shaped, e.g. "asymmetrical propeller", col. 10, lines 61-64 and col. 11, line 53-col. 12, line 27, e.g. not all the aberrations or hooks are coated on the top, some can be uncoated, col. 14, lines 44-55, e.g. landing member can be loop material, col. 18, lines 19-21, and col. 19, lines 9-14, and Hartmann at, see English translation, i.e. Malowaniec US '525, at the abstract, Figures, col. 2, lines 40-61, col. 3, lines 7-14, e.g. can be hook shaped, col. 4, lines 14-25, e.g. loop member, teach that a textured pressure sensitive adhesive area comprised of "hooks" and pressure sensitive adhesive and cooperating with a "loop" area provides enhanced and more reliable adhesive securement than an untextured adhesive area in addition to other desirable features, i.e. ability to check and disposal ability, in a diaper. Therefore, to make the pressure sensitive adhesive area of Lingertat a textured pressure sensitive adhesive area as taught by Battrell and Hartmann instead would be obvious to one of ordinary skill in the art in view of the recognition that such a feature provides

enhanced and more reliable securement and the desirability of securement by Lingertat as well as other features found to be desirable in any diaper such as the ability to check for soilage without degradation of the fastener and the ability to arrange the diaper for disposal. With regard to 2), see again the cited portions of the prior art, e.g. col. 2, lines 40-61 of '525 as well as col. 1, line 21-col.2, line 39 thereof and the discussion in 1) supra. Therefore, the prior art combination necessarily and inevitably teaches adhesive layers having a holding force against the outside thereof sufficient to hold the diaper in a rolled up state after use.

In regard to claim 12, see Claim Language Interpretation section supra and, e.g., the cited portions of '276 and '525 as well as the last full paragraph of col. 2 of '276, i.e. adhesive layers peelable from loop member, and 1) and 2) supra. Therefore, the prior art combination necessarily and inevitably teaches a loop member, i.e. the surface thereof, having the capability, property or function of facilitating peeling of the adhesive layers therefrom.

Claim 13 further claims the holding forces between the adhesive layers and loop member is not higher than the holding forces between the hook and loop members which the prior art does not teach explicitly. However see '276 at, e.g., col. 2 last full paragraph and the discussion in 1) and 2) supra. Therefore it is the Examiner's first position that the prior art combination necessarily and inevitably teaches such holding forces relationship because if the loop/adhesive holding forces were greater than the hook/loop holding forces, the diaper would not be refastenable or reuseable because the loop material and/or layer(s) it is attached to would stretch, elongate, deform and/or break as the hook and loop members were disengaged. In any case, the Examiner's second position, the prior art teaches a fastening system in which the forces are such so as to fasten during use yet easily allow checking for soiling or to remove without rendering

the system unrefastenable or unuseable, e.g. allow the fasteners to be peeled open “smoothly” (the terminology “smooth peeling”, absent claiming of specific dimensions thereof, is considered relative). Therefore, where the general conditions of a claim are disclosed in the prior art such as here it is not inventive to discover the optimum or workable ranges, i.e. the claimed range of the holding force of the adhesive/loops and the claimed range of the holding force of the hooks/loops which permit such, i.e. the former range being no more than the latter, by routine experimentation, see *In re Aller*, 105 USPQ 233.

With regard to claims 14-16, which claims are broader than the claims 11-13, e.g. they don’t require release zones defined by the backsheet, see the discussion of claims 11-13.

#### *Response to Arguments*

8. Applicant’s remarks in the preliminary amendment filed 1-16-04 have been considered but are deemed not persuasive for the reason set forth *supra*. It is noted that the prior art references, alone or in any combination, do not teach the invention of claims 8-10 for the same reasons set forth in the parent application with respect to claim 19.

#### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure. The cited, but not applied, prior art include the issued parent application and references cited therein not yet of record in this application. Copies of the latter are not being provided. The ‘115 patent, not of good date, shows folded extensions.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 3761

KMR  
January 17, 2006